

Notice of Allowability

Application No.

09/889,821

Examiner

Ashwin Mehta

Applicant(s)

SELA ET AL.

Art Unit

1638

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address–

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to papers filed August 5, 2005.
2. ☒ The allowed claim(s) is/are 27,28,33,37,40 and 53-57.
3. ☒ The drawings filed on 03 December 2001 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

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Status of Amendments submitted under 37 CFR 1.116

1. The amendment after final rejection submitted May 19, 2005 has not been entered. The supplemental amendment after final rejection submitted August 5, 2005 has been entered.

Claim Objections and Rejections

2. The objections to claims 17-19 are withdrawn, in light of their cancellation.
3. The rejection of claims 20, 22-24, 26, and 40-42 under 35 U.S.C. 112, second paragraph, are withdrawn in light of their amendment or cancellation.
4. The rejections of claims 6, 11, 20, 22-24, 26, 30, 34, 38, and 41 under 35 U.S.C. 112, first paragraph, are withdrawn in light of their cancellation.
5. The rejection of claims 1-7, 13-15, 17, and 43 under 35 U.S.C. 102(b) is withdrawn in light of the claim cancellations.
6. The rejection of claims 1-7, 9, 13-17, 20-24, 26-30, 33, 34, 37, 38, and 40-43 under 35 U.S.C. 103(a) is withdrawn in light of the claim cancellations and Applicants' arguments.

Allowable Subject Matter

7. Claims 27, 28, 33, 37, 40, and 53-57 are allowed.

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8. The following is an examiner's statement of reasons for allowance: Applicants have developed a method to use the T7 RNA polymerase/T7 promoter expression system to cause the post-transcriptional silencing of a target sequence in plant cells and plants. The prior art teaches this expression system, and its use to overexpress genes of interest in plants (Lassner et al., Plant Mol. Biol., 1991, Vol. 17, pages 229-234). A rejection under 35 U.S.C. 103(a) was applied over claims directed to a method of silencing the expression of a target sequence within the genome of a plant or plant cell, using Lassner et al. as the primary reference. In response, Applicants have argued that Lassner et al. teach using the T7 expression system to express genes of interest, not to inhibit their expression, as required in the instant methods (response, page 29, 1st-3rd full paragraphs). Further, Applicants have also argued that the prior art does not teach why one would have been motivated to use the T7 expression system to cause gene silencing. Applicants have pointed out that in the years since the publication of Lassner et al., the T7 system was never employed to silence a target gene in any cell type, and that commercial kits remain available and sold for the intended purpose of causing expression of a desired gene product, not inhibition of expression (response, paragraph bridging pages 29-30). This argument has been found persuasive. While the prior art has numerous examples of post-transcriptional gene silencing of a target sequence in plant cells and plants, the prior art does not fairly suggest or provide motivation to use particularly the T7 expression system for this purpose.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Contact Information

Any inquiry concerning this or earlier communications from the Examiner should be directed to Ashwin Mehta, whose telephone number is 571-272-0803. The Examiner can normally be reached from 8:00 A.M to 5:30 P.M. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Jones, can be reached at 571-272-0745. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.



Ashwin D. Mehta, Ph.D.
Primary Examiner
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August 22, 2005